

REMARKS

I. Pending claims

Claims 1-9, 11-17, 19, 20, 24-28 and 46 are currently pending. Applicants expressly do not disclaim the subject matter of any invention disclosed herein which is not set forth in the instantly filed claims. Applicants reserve the right to prosecute the non-elected claims in subsequent divisional applications.

II. Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1, 2, 16 and 17) drawn to polypeptides.

Group II (claims 3-7, 9, 11, 12, and 46) drawn to polynucleotides, a vector, a host cell, and methods of expression.

Group III (claim 8) drawn to a transgenic organism.

Group IV (claims 13-15) drawn to a method of detecting polynucleotides.

Group V (claims 19 and 26) drawn to a method of screening a compound for effectiveness as an agonist of a polypeptide or a method of screening for a compound that modulates the activity of a polypeptide.

Group VI (claim 16) drawn to a composition comprising an agonist identified by a method of claim 19.

Group VII (claim 24) drawn to a method for treating a disease or condition associated with overexpression of functional TRXP.

Group VIII (claim 25) drawn to a method of screening for a compound that specifically binds to a polypeptide.

Group IX (claim 27) drawn to a method of screening a compound for effectiveness in altering expression of a target polynucleotide.

Group X (claim 28) drawn to a method of assessing toxicity of a test compound.

Applicants hereby elect, **with traverse**, to prosecute Group II (claims 3-7, 9, 11, 12, and 46) as directed to SEQ ID NO:4. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants submit that the invention encompassed by Group IV (claims 13-15), drawn to a method of detecting polynucleotides, Group IX (claim 27), drawn to a method of screening a compound for effectiveness in altering expression of a target polynucleotide, and Group X (claim 28), drawn to a method of assessing toxicity of a test compound, could and should be examined together with the product claims from which they depend. The method claims of Groups IV, IX, and X recite a product (i.e., a polynucleotide), which is of the same scope as the claimed polynucleotides being searched by the Examiner. Thus, it would pose no undue burden on the Examiner to examine these method claims since a search of the prior art to determine the novelty of the claimed polynucleotides would substantially overlap with a search of the prior art to determine the novelty of the method claims.

Additionally, Applicants respectfully remind the Examiner that the method claims of Groups IV, IX, and X are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.


Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of Groups II, IV, IX, and X.

Applicants additionally note that the Examiner has placed claim 16 into two different Groups (I and VI). Clarification is requested.


Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,
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